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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,908	11/16/2001	David Strutt	02310.0054	7906
22852	7590	03/31/2008	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ROBERTSON, DAVID	
			ART UNIT	PAPER NUMBER
			3623	
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			03/31/2008 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/987,908

**Applicant(s)**

STRUTT ET AL.

**Examiner**

Dave Robertson

**Art Unit**

3623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 31, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 31, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 1/8/2008.

### **DETAILED ACTION**

1. This is a Final office action in response to Applicant's reply of 1/8/2008 and amendments of 6/18/2007.
2. The reply of 6/18/2007 was in response to the Non-final Office Action of 1/18/2007. The reply was considered bona fide though non-responsive with respect to a Rule 1.105 Requirement for Information made in the office action. The reply of 1/8/2008 was in response to the Miscellaneous Communication of 7/10/2007 granting Applicant additional time to complete a response to the Rule 1.105 Requirement. Applicant has properly availed of Extensions of Time in responding to the prior office action and Requirement for Information. The cumulative response is addressed herein.
3. Claims 1-16, 31, 34 and 35 are pending.

### ***Response to Amendment***

4. Applicant amends claims 1, 2, 15, 16, 31, 34, and 35 to address rejections under 35 U.S.C. 112, 2nd paragraph, made in the office action of 1/18/2007. These amendments are addressed below.
5. Applicant cancels claims 17-30, 32, and 33. Accordingly, rejections of these claims under 35 U.S.C. 102 and 103(a) are withdrawn.
6. Applicant amends the Specification to claim benefit under 35 U.S.C. 119(e) to the US Provisional 60/262,361 filed January 19, 2001 and under 35 U.S.C. 119 (a-d) to Canadian applications 2,339,063 and 2,349,227. The priority applications have been properly referenced and perfected for priority, however, Applicant should consult 37

CFR 1.57 (see MPEP 201.17 [R-3] Incorporation by Reference Under 37 CFR 1.57(a)) to ensure that material in the provisional and foreign priority documents is properly included in the disclosure of the present and continuation applications if any. Applicant should also note the change in rules effective September 21, 2004, regarding incorporation by reference of earlier filed and priority application documents.

### ***Response to Arguments***

7. Applicant's arguments filed 6/18/2007 in view of the reply of 1/8/2008 in response to the Non-final office action of 1/18/2007 have been fully considered but they are not persuasive:

8. Applicant argues over the rejection of claims 1-16, 31, 34, and 35 as non-statutory under 35 U.S.C. 101 asserting that replacing "representing" with "configurable to represent" renders an ability to configure a business model comprising "sets of dimensions...; sets of measures... and relationships" patentable subject matter, and therefore makes the invention as claimed statutory.

Examiner respectfully disagrees: Changing "representing" to "configurable to represent" does not result in a functional difference to what continues to be claimed as a mere arrangement of data without function. Reciting an arrangement of data (sets of dimensions..., sets of measures..., relationships...) in a "business model" as being "configurable to represent" does nothing to place the claim into one of the four statutory classes of invention: process, machine, manufacture, or composition of matter. Data being "configurable to represent" does not result in a process of configuring, and data

per se is non-functional. Even taking "a business model...comprised of sets of measures, sets of dimensions, and relationships..." to be *data* is a stretch from the abstract notion of *data representation* (i.e. a model) as there is no recited structure or acts, nor means or medium on which the data could become functional if such structure or acts were claimed.

9. Similarly with respect to rejections made under 35 U.S.C. 112, 2nd paragraph, Applicant argues "configurable to represent" renders the claims definite. For reasons explained directly above, "configurable to represent" does not add to an understanding of what the Applicant is intending to claim: process, machine, manufacture, or composition.

10. Applicant argues over the statutory double patenting rejection of claim 35 with respect to claim 44 of co-pending Application No. 09/987,905. Claim 44 being now cancelled from the co-pending application, this rejection is withdrawn.

11. Applicant argues over the non-statutory double patenting rejection of claims 1, 17 and 34 with respect to claims of co-pending Application No. 09/987,905. Claim 17 of the present invention is now cancelled. For claims 1 and 34, a nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not patentably distinct from the reference claim(s) because the examined application claim would have been obvious over, the reference claim(s). In the present case of the two applications, a "business model...configurable to represent" must in its implementation, to be "configurable", have a configuration unit. Therefore, claims to an

apparatus having a generically recited "configuration unit" are not patentably distinct from an invention requiring some means of configuration.

12. Accordingly, the grounds of rejection over all pending claims as in the prior office action are maintained.

***Response to Rule 1.105 Requirement***

13. Applicant's response of 1/8/2008 with regard to the Rule 1.105 Requirement for Information made in the office action of 1/18/2007 is appreciated. The submitted prior art taken in conjunction with the telephone interview of 10/9/2007 held in co-pending and related US Application US 09/987,905, along with the provisional and Canadian priority documents, has greatly improved the Examiner's understanding of the progression of development of the Assignee's related software products in the time period prior to and into the filing dates of the various applications.

14. Certain of these prior art documents, however, strongly suggest at least the broadest claims of the present invention. Taking a broadest reasonable interpretation of claim 1 for example, the article "Cognos Introduces Unparalleled Foundation for End-to-End Business Intelligence," PR Newswire, July 6, 1999, published 18-months prior to the filing date of the earliest priority document, discloses a software product *DecisionStream* implementing a business (database) model comprising "a set of dimensions...; a set of measures...; and relationships..." forming a "complete enterprise solution...a foundation that quickly and easily evolves into an enterprise business intelligence solution." In "Cognos Introduces First End-to-End Platform for True

Enterprise Business Intelligence Solutions," FHC Press Release, 17 September 1999, Cognos is reported to have released the "Cognos Platform" described therein as "an integrated meta data modeling...datamart building...platform...providing a fully integrated foundation for enterprise-wide business intelligence solutions." The Cognos Platform is further described in the press release as a tool that "encompasses BI datamart modeling, transformation, and creation that supports shared, conformed, cross-enterprise dimensions." Putting the *DecisionStream* product offering information together with the Applicant submitted prior art *Kimball* (1998, 1996) on data mart and data warehouse building, these press releases appear to offer for a sale a product which implements the "Data Warehouse Bus Architecture" described by Kimball (pages 153-166) which expressly describes enterprise-wide *conformed* dimensional database architecture (see page 158) as the preferred method of building data warehouse architecture in support of integrated datamarts. Examiner notes that for sale or use doctrine does *not* require that prior disclosure teach all aspects of the claimed invention. Still, as to the broad claims of the present invention, one of ordinary skill in the art would find these releases strongly suggestive of a product offering covering at least the broadest claims.

15. The Examiner believes that further Requirements for Information including detailed technical descriptions of at least the software product *DecisionStream* may be required to distinguish the broad claims of the present invention over the product reported as released prior to the grace period for the earliest priority date, however, no Requirement will be currently made until Applicant has had an opportunity to review

Art Unit: 3623

discussions herein and respond accordingly with respect to the intent and direction of the claims of the present application, as discussion in previous interviews held in this and the related application.

### ***Double Patenting***

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees:

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

17. Claims 1-16, 31, 34, and 35 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-21, 23-43, and 45-49 of copending Application No. 09/987905 to common assignee and inventors. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Independent claims of the present invention recite "a set of dimensions...and a set of measures...configurable to represent..." as in corresponding claims of the copending application; however, claims 1 and 34 do not claim a "configuration unit" or "placeholders." One of ordinary skill in the art would readily recognize that a "business



Art Unit: 3623

model...comprising sets of dimensions...and sets of measures...which are configurable to represent..." must in implementation, to be "configurable", employ a "configuration unit" and "placeholders" for the data which is entered for the configuring. Therefore, claims to an apparatus having a generically recited "configuration unit" and "placeholders" are not patentably distinct from an invention having sets of dimensions and measures requiring some means of configuration.

***Claim Rejections - 35 USC § 101***

18. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

19. Claims 1-16, 31, 34 and 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims to mere arrangements of data are non-statutory under 35 U.S.C. 101. Mere claiming of nonfunctional descriptive material in a computer does not make it statutory. See MPEP 2106.01 [R-5].

An invention is statutory subject matter if the invention as a whole: a) falls into one of the statutory classes of invention (process, machine, manufacture, or composition of matter); and b) is useful (has a particular use or advantage conferring a benefit); and c) is not a judicially created exception to patentable subject matter (law of nature, abstract idea, or natural phenomenon) without practical application; and d) does not preempt all uses of a judicially created exception to patentable subject matter. MPEP [r5] § 2106 Patent Subject Matter Eligibility.

Claim 1 recites "A business model...comprising a set of dimensions... a set of measures... and relationships between the set of dimensions and measures..." As such, the claim is directed to a mere arrangement of data without function. Claims 2-16

recite further arrangements of data (e.g. groupings of dimensions). Similarly, Claim 31 recites a "A dimensional framework...comprising...a set of dimensions..." Because these claims do not fall within a statutory class of subject matter, process, machine, manufacture, or composition of matter, they are non-statutory.

Whereas claims 1 and 31 recite no computer-related implementation, Claims 34 and 35 embody the non-functional descriptive material of claims 1 and 31 as "computer program product." Still, non-functional descriptive material, even if recorded on computer-readable medium (note that no medium is in fact claimed), remains non-statutory if no requisite functionality with or among the data structures thus created (by the data store) is present. Applicant claims no functionality, e.g. "representing" is a non-functional descriptor imparting abstract meaning but no functionality within or on the claimed arrangement of data.

Applicant is advised that this is not merely an issue with the preamble of the claims. Alternatively claiming "A system..." rather than "A business model..." with the same recited elements would not render the claims statutory, as no functionality will have been recited with or among the elements of the claim.

Amendment or cancellation of the claims is requested.

***Claim Rejections - 35 USC § 112***

20. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

21. Claims 1-16, 31, 34 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As above under the heading 35 USC § 101, the claims recite mere arrangements of data per se. Examining these claims on the merits would require speculation as to applicant's intent in claim a functional arrangement of data and as to what functionality would apply. See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection on these assumptions). Furthermore, speculation as to Applicant's intent may invoke an unnecessary and improper restriction between sets of claims to a specific database or structure (assuming such claims are made statutory) versus a method of creating an integrated, shared-dimension, and cross-functional business process data warehouse.

Amendment or cancellation of the claims is requested.

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is (571)272-8220. The examiner can normally be reached on 8:45am to 4:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dave Robertson/  
Examiner, Art Unit 3623

/Romain Jeanty/  
Primary Examiner, Art Unit 3623